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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/757,333 | 01/09/2001 | Samuel I. Achilefu | MRD-67 | 5506 |

7590 01/29/2003

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 01/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | |
|------------------------------|-------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/757,333 | ACHILEFU ET AL. |
| | Examiner D. L. Jones | Art Unit 1616 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 November 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

PREVIOUS ACTION VACATED

1. The previous action is vacated in view of the action set forth below.

RESTRICTION INTO GROUPS

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to compounds, compositions, and uses thereof wherein in the formula W5 and X5 are CR1R2, classified in class 548, subclass 400+.
 - II. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is CR1R2 and the other is oxygen, classified in class 548, subclass 215+.
 - III. Claims 1, 2, 4, 5, and 7-19, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is CR1R2 and the other is NR3, classified in class 548, subclass 300.1+.
 - IV. Claims 1, 2, 4, 5, and 7-19, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is CR1R2 and the other is sulfur, classified in class 546, subclass 146+.
 - V. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is CR1R2 and the other is selenium, classified in class 548, subclass 100+.

- VI. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula W5 and X5 are oxygen, classified in class 548, subclass 215+.
- VII. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is oxygen and the other is NR3, classified in class 548, subclass 215+.
- VIII. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is oxygen and the other is sulfur, classified in class 548, subclass 146+.
- IX. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is oxygen and the other is selenium, classified in class 548, subclass 100+.
- X. Claims 1, 2, 4, 5, and 7-19, drawn to compounds, compositions, and uses thereof wherein in the formula both of W5 and X5 are NR3, classified in class 548, subclass 300.1+.
- XI. Claims 1, 2, 4, 5, and 7-19, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is NR3 and the other is sulfur, classified in class 548, subclass 146+.
- XII. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is NR3 and the other is selenium, classified in class 548, subclass 100+.

XIII. Claims 1, 2, 4, 5, and 7-19, drawn to compounds, compositions, and uses thereof wherein in the formula both of W5 or X5 are sulfur, classified in class 548, subclass 146+.

XIV. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula one of W5 or X5 is sulfur and the other is selenium, classified in class 548, subclass 100.

XV. Claims 1, 4, and 7-18, drawn to compounds, compositions, and uses thereof wherein in the formula both of W5 and X5 are selenium, classified in class 548, subclass 100+.

Note: Claims appearing in more than one group will only be examined to the extent that they read on the elected group.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I-XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the inventions are different because they have no common core. In particular, depending upon the values of W5 and X5, the compounds structurally different. Hence, a search of one group of compounds, compositions, and uses thereof would neither anticipate nor render obvious compounds, compositions, or uses thereof of a different group.

ELECTION OF SPECIES (for search purposes)

4. The claims are directed to a plurality of disclosed patentably distinct species comprising hydrophilic dyes. In particular, the dyes may have the formula as set forth in independent claims 1, 4, and 18 wherein X5 and W5 independently may be CR1R2, O, NR3, S, or Se. Thus, since the compounds are structurally different, Applicant is respectfully requested to elect a single disclosed species for search purposes.
5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
6. Due to the complexity of the restriction requirement, a telephone call was not made to request an oral election to the above restriction requirement.
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D. L. Jones
Primary Examiner
Art Unit 1616

January 28, 2003